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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/594,445	06/15/2000	Beth N. Grijalva	GRIJ-0002-US	8014

7590 11/27/2002

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EXAMINER

HAMILTON, LALITA M

ART UNIT PAPER NUMBER

3764

DATE MAILED: 11/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No. 09/594,445	Applicant(s) GRIJALVA, BETH N.	
Examiner Lalita M Hamilton	Art Unit 3764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on amendment filed on September 11, 2002.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-56 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-56 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) Notice of References Cited (PTO-892)
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) Interview Summary (PTO-413) Paper No(s). _____
- 19) Notice of Informal Patent Application (PTO-152)
- 20) Other:

DETAILED ACTION

Summary

On May 22, 2002, an Office Action was sent to the Applicant rejecting claims 1-45. On August 28, 2002, the Applicant responded by amending claims 2-3, 31, and 33 and adding new claims 46-56.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection to claims 2-3, 31, and 33 under 35 U.S.C. 112, second paragraph remains. In claims 1 and 30, merely claiming that the eye patch is "usable with eyeglass frames" does not mean that the eyeglass frames have been positively recited.

Claims 46-51 are rejected under 35 U.S.C. 112 second paragraph for being vague and indefinite. In claim 46, the term "version" should be "vision". Claims 47-51 are rejected for their dependency upon claim 46.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11, 13-25, 27-41, and 43-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Heaford ('077), as set forth in the previous Office Action, set forth in paper no.11.

Claims 46-48 and 52-56 are rejected under 35 U.S.C. 102(b) as being anticipated by Grindle.

Grindle discloses an eye patch for use with eyeglasses comprising a flexible body having a first portion (24) and second portion (22), which block the frontal and peripheral vision of the eye (col.2, lines 4-6), the portions being opaque (col.4, lines 64-66), the second portion adapted to extend partially along the side arm (fig.1), and the first and second portions together forming a loops that extend around the bridge and side arm to attach both to the body (fig.1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12, 26, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heaford in view of Grindle ('401), as set forth in paper no.11.

Claims 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grindle in view of Mosher (2,687,524).

Grindle discloses the invention substantially as claimed; however, Grindle does not disclose the first fastener comprising a loop having a first end secured to the body and a second end adapted to extend around the bridge and releasably couple the bridge to the body, a releasable connector adapted to releasably couple the side arm to the body, or a second fastener comprising a loop adapted to extend around the side

arm, wherein the loop has a first end secured to the body and a second end. Mosher teaches a removable eyeshade for eyeglasses comprising a first fastener forming a loop (fig.2-3: 32), a releasable connector (30), and a second fastener forming a loop (31), wherein the loop has a first end secured to the body and a second end. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the first fastener comprising a loop, a releasable connector, and a second fastener comprising a loop as taught by Mosher onto the device disclosed by Grindle to provide a separate and alternative fastening means.

Response to Arguments

Applicant's arguments filed August 28, 2002 have been fully considered but they are not persuasive. The Applicant has argued that the Heaford reference does not teach nor suggest a flexible body that substantially blocks both frontal and peripheral vision of the eye. In response, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations *Ex parte Masham*, 2 USPQ2d 1647 (1987). The Applicant claims a flexible body and then claims that the "body is to be positioned on a front of the frame to substantially block both frontal and peripheral vision of an eye". The main structural component of that portion of the claim is the flexible body. The assertion that it should be able "to block both frontal and peripheral vision of an eye" is intended use.

In response to the Applicant's argument on intended use, please refer to the response above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

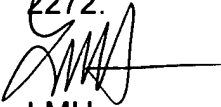
The fax phone numbers for the organization where this application or proceeding is assigned are (703) 306-4520 for regular communications and (703) 306-4520 for After F

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-

2272.



LMH



**NICHOLAS D. LUCCHESI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700**

November 20, 2002